

Application No. 10/803,424
Amendment dated February 28, 2006
Reply to Office Action of November 29, 2005

Docket No.: 30320/19116

REMARKS

Claims 1-29 are pending and at issue. Each of these claims stand rejected under 35 U.S.C. 103 as obvious over Machado et al. (U.S. Publication 2003/0228799, now U.S. Patent No. 6,848,943). Applicant appreciates the examiner's attention to this application and review of the pending claims. In response, applicant respectfully traverses the obviousness rejections for at least the reasons outlined below. Reconsideration is respectfully requested.

There are three independent claims in the application: apparatus claims 1 and 16 and method claim 25. Each makes reference to a latching mechanism that has "a slotted mating element" for coupling to a pivot element of a housing. The specific recitation in claim 1, for example, is:

a latching mechanism movable between a latching position and a delatching position, the latching mechanism comprising a slotted mating element for coupling to the pivot element for rotational movement relative thereto, a latch movable in response to rotational movement of the slotted mating element, and a cam follower; and

As shown in various examples of the present application, the creation of a latching mechanism with such a slotted mating element allows the latching mechanism to be fitted to a housing for improved operation during latching/delatching. The slotted mating element maintains a tighter fitting around the pivot element to address the problem conventional latching mechanisms have (mechanisms like that of Mechado et al.) of being too loose during operation. By having a slotted mating element, the latching mechanism, under biasing, may maintain continuous contact with the pivot element throughout the range of rotational movement from the latching to delatching positions. Thus, position-dependent looseness in the device is avoided, allowing for more consistent and predictable device operation.

The office action concedes, correctly, that Mechado et al. does not teach the recited latching mechanism with a slotted mating element. Mechado et

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al.'s latching mechanism is a flat plate 289 that has no slotted mating element whatsoever, but instead appears to engage a pivot rod that, as shown in figure 2o, loosely rests in a cylindrical recess in the housing. Although the office action recognizes that the flat plate 289 has no slotted mating element, the office action still rejects claim 1 because, per the office action, "for the skilled person, this [the latching mechanism with slotted mating element] represents an obvious alternative to the pivot arrangement disclosed in the Machado et al reference." The office action points to nothing in the prior art as teaching or suggestion this modification to Machado et al.; the office action certainly identifies no place in Mechado et al. for this teaching. In fact, the office action provides none of the *prima facie* showing required to make an obviousness rejection.

In order to establish *prima facie* obviousness, there must be actual evidence of a suggestion to modify a prior art reference or to combine two prior art references, and the suggestion to combine or modify the prior art must be clear and particular. See, for example, *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999), where the Court of Appeals for the Federal Circuit stated:

We have noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved...

* * *

The range of sources available, however, does not diminish the requirement for **actual evidence**. That is, the showing must be **clear and particular**. Broad conclusory statements regarding the teaching of multiple references, standing alone, are **not 'evidence.'** (emphasis added, citations omitted).

As instructed many times, both the suggestion to try and the expectation of success must be found in the prior art, not in the applicant's disclosure. *Amgen Inc. v. Chugai Pharmaceutical Co. Ltd.*, 927 F.2d 1200, 1207 (Fed. Cir. 1991), citing *In re Dow Chemical Co.*, 837 F.2d 469, 475 (Fed. Cir. 1988). The mere fact that references can be modified is not sufficient to establish a prima

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facie case of obviousness. See Section 2143.01 of the M.P.E.P., which states: "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)" (emphasis original).

To establish *prima facie* obviousness, there must be some teaching, suggestion, or motivation from the prior art to make the proposed combination or modification. Absent any teaching or suggestion of using a latching mechanism with a slotted mating element as recited, the office action appears to be engaged in impermissible hindsight. In fact, the only teaching of using a slotted mating element is not in the prior art, but the applicant's own disclosure, and that cannot form the basis of an obviousness rejection.

As explained by the Federal Circuit, to avoid impermissible hindsight, "the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998) (citations omitted). Given the "subtle but powerful attraction of a hindsight-based obviousness analysis, the Federal Circuit has required a rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999).

The requirement for a *prima facie* showing is both substantive and procedural. See, e.g., *In re Lee*, 277 F.3d 1338, 1343, citing *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"). As the Federal circuit stated in *In re Rouffet*, 149 F.3d 1350, 1359, 47 U.S.P.Q.2d 1453, 1459 (Fed. Cir. 1998): even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the

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reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.

The examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). In the instant case, the office action's rejection does not rise to the level of a *prima facie* showing.

The rejection of claim 1 as obvious over Mechado et al. is respectfully but strongly traversed.

In addition to the lack of any *prima facie* showing with respect to the rejection of claim 1, applicant notes that the office action also has not shown where various specific recitations from the dependent claims are taught in the prior art. With respect to claim 1, for example, the office action concludes the biasing plate 296 of figure 2p is the recited biasing apparatus, and the latch plate 289 is the latching mechanism. In claim 5, where the biasing apparatus is described as having a first support member and a second support member, the office action (apparently) starts pointing to descriptions of the latch plate 289 and its "wider part towards the rear of the plate" and "narrower part towards the front of the plate." In other words, the office action calls Mechado et al.'s "latch plate" a latching mechanism in rejecting claim 1, but then treats that "latch plate" as a biasing apparatus in rejecting claim 5. If biasing plate 296 is the biasing apparatus of claim 1, there is certainly no teaching or suggestion that it has parts of different thickness or, that the plate 296 has a first support biasing a slotted mating element and a second support biasing a cam follower (claim 6), or that first and second supports are moveable relative to one another (claim 7), or that first and second supports are on a cantilever arm and are at least partially spaced from one another (claim 8).

With respect to claim 9, the office action points to paragraphs [0091] and [0093] in concluding that it would have been obvious to have first and second

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supports that are independently mountable to the housing. Paragraph [0091], however, is directed to the "the latch plate 289," noting that a spring may be disposed inside the housing to return the plate to its rest position. There is no teaching or suggestion of a second support or any teaching or suggestion of a biasing apparatus having independently mountable supports. Paragraph [0093] appears to be similarly directed, and certainly cannot be said to provide the subject matter of claim 9.

The rejections of claim 1 and claims 2 – 15 are traversed for the foregoing reasons.

With respect to claim 16, that claim is directed to a computer board assembly comprising an optical module having a latching mechanism like that of claim 1. Therefore, for at least the foregoing reasons, the rejection of claim 16 and claims 17- 24 depending therefrom are traversed.

With respect to claim 25, that claim is a method claim directed to a method of selectively latching and delatching an optical module from a cage having a latch recess. Claim 25 recites:

coupling a slotted mating element of a latching apparatus to a tubular-shaped pivot element of a housing, the slotted mating element being coupled to a latch extendible into the latch recess;

biasing the slotted mating element into contact with the pivot element for rotational movement of the slotted mating element about an axis of the pivot element; and

manually actuating an actuator from a first position to a second position, wherein the latching apparatus is in a latching position when the actuator is in the first position and a delatching position when the actuator is in the second position.

In other words, claim 25 recites a method comprising coupling a slotting mating element of a latching apparatus to a pivot element, and biasing that slotted mating

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element into contact with the pivot for rotational movement above the pivot element's access.

For at least the foregoing reasons, the rejection of claim 25 and claims 26-29 depending therefrom are in condition for allowance.

In view of the foregoing, applicants respectfully submit that all pending claims are in condition for allowance. An early action so indicating is respectfully requested. If the examiner would like to discuss this response, the examiner is invited to contact the below-signed representative.

Dated: February 28, 2006

Respectfully submitted,

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